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| 09/882,688 | 06/13/2001 | Stuart Creque | CREQ-502 | 4474 |

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Andrew V. Smith
Sierra Patent Group
P.O. Box 6149
Stateline, NV 89449

| EXAMINER | |
|---|---|
| NGUYEN, THU HA T | |

| ART UNIT | PAPER NUMBER |
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| 2155 | |

DATE MAILED: 06/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

| Office Action Summary | Application No. | Applicant(s) | |
|---|---|---|---|
| | 09/882,688 | CREQUE, STUART | |
| | Examiner | Art Unit | |
| | Thu Ha T. Nguyen | 2155 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on *02/25/05*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *1-20* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-20* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

## D ETAILED ACTION

1. Claims **1-20** are presented for examination.

2. Claims **18-20** are newly added.

## Response to Arguments

3. Applicant's arguments with respect to claims 1-20 have been considered but are moot in view of the new ground(s) of rejection.

4. Applicant's argument with respect to claims 1 and 5 have been consider. However, examiner submits that since applicant's amendment necessitated the new ground(s) of rejection presented in this Office action.

5. Applicant argues that Rabin does not teach or suggest the step of capturing at least one physical feature of a requested content with a data capture device. In response to applicant's argument, examiner asserts that the digital data representation of at least one physical feature of said requested content has been captured from a data capture device (abstract, figure 1, col. 3, lines 2-63, col. 4, lines 54-65, col. 11, lines 20-30 –*the image data captured by either scanner 18 or camera 24 (i.e., data capture device))*.

6. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)and *In re*

*Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the reason to incorporate a data capture device that capture digital data into the Bengtson system because it were conventionally employed in the art to provide an efficient communications system to collect, capture, store and distribute written and optical information over the network (see Rabin col. 1, lines 11-15).

7. Therefore, the examiner asserts that cited prior art teaches or suggests the subject matter broadly recited in independent claims 1and 5. Claims 2-4, and 6-20 are also rejected at least by virtue of their dependency on independent claims and by other reasons set forth in this office action [see rejection below].

8. Applicants still have failed to identify specific claim limitations that would define a patentable distinction over cited prior arts. Accordingly, claims 1-20 are rejected below.

**Claim Rejections - 35 USC § 103**

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

10. Claims 1-20 are rejected under 35 U.S.C. §103 (a) as being unpatentable over **Bengtson**, in view of **Rabin** U.S. Patent No. **6,603,464**.

11. As to claim 1, Bengtson teaches the invention as claimed, including a software program running on a content server computer having access to a content repository, said content repository comprising a digital representation of a published content in a layout-preserving format, the program providing instructions for one or more processors of the server computer to perform the steps of:

receiving a content retrieval request comprising a digital data representation of at least one physical feature of a requested content, and said at least one physical feature of said requested content is mapped to said digital representation of said published content is said content repository (figures 1, 5, block 502, 506, 508, paragraphs 00005-0007, 0047-48-*receiving print data from printing system/optical scanning/OCR operation, mapping key words/phrases with page numbers to create indexing*);

parsing the digital data representation of at least one physical feature to identify the requested content from the digital data representation (figure 5, block 504, paragraph 0048 –*parsing print data into key words/phrases to map with predetermined attributes*);

retrieving the digital representation of the published content that is mapped to the at least one physical feature of the requested content from the content repository (figure 5, 506, paragraph 0048 –*searching/retrieving print data for words to map with one or more predetermined attributes*);

comparing the digital representation of the published content retrieved to the at least one physical feature of the requested content (figure 5, block 508, paragraph 0048-0049);

extracting the requested content from the published content retrieved (figure 5, block 508, 510, paragraph 0049); and

responding to the content retrieval request (figures 5-6, paragraphs 0049-0050).

Bengtson does not explicitly teach a data capture device captures the digital data representation of at least one physical feature of said requested content. However, Bengtson teaches the step of receiving print data from printing system/optical scanning/OCR operation (figure 5, block 502). It would have been obvious to one of ordinary skill in the art to recognize that the digital data representation of at least one physical feature of said requested content has been captured from a data capture device (i.e., printing system/optical scanning/OCR operation). Therefore, it were conventionally employed in the art to include a data capture device capturing a digital data representation of at least one physical feature of said requested content because it would have provided an efficient system to generate and provide a printed publication from the print data provided.

Moreover, in order to support the obviousness of the digital data representation of at least one physical feature of said requested content has been captured from a data capture device. Rabin teaches the digital data representation of at least one physical feature of said requested content has been captured from a data capture device (abstract, figure 1, col. 3, lines 2-63, col. 4, lines 54-65, col. 11, lines 20-30). It would

have been obvious to one of ordinary skill in the Data Processing art at the time of the invention was made to combine the teachings of Bengtson and Rabin to include data capture device captures at least one physical feature of a request content because it would have an efficient communications system to collect, capture, store and distribute written and optical information over the network.

12. As to claim 2, Bengtson teaches the invention as claimed, wherein the data capture device includes an OCR wand (figure 1).

13. As to claim 3, Bengtson teaches the invention as claimed, wherein the content is unencoded with any document identifier other than physical features of the content including the at least one physical feature captured with the data capture device (paragraphs 0005-0008).

14. As to claim 4, Bengtson teaches the invention as claimed, wherein the content of the content repository is indexed according to physical features of the content (paragraphs 0005-0008, 0038, 0048-0049).

15. As to claim 5, Bengtson teaches the invention as claimed, including a method of retrieving content from a content repository, said content repository comprising a digital representation of a published content in a layout-preserving format, said method comprising the operations:

at least one physical feature of said published content is mapped to said digital representation of said published content is said content repository (figures 1, 5, block 502, 506, 508, paragraphs 00005-0007, 0047-48- *mapping key words/phrases with page numbers to create indexing*);

uploading a digital representation of the at least one physical feature of the published content to a personal computing device (paragraphs 0026-0027, 0049, 0053- *transmits data related to the target network address which may be a digital version of a printed publication to client device*);

sending a request over a network to a content server having access to said content repository, which content server retrieves the published content from the content repository (figures 1, 5, block 502, paragraphs 00005-0007, 0047, 0049-0053); and

receiving a response from the server including the published content (figures 5-6, paragraphs 0049-0050).

Bengtson does not explicitly teach a data capture device captures the digital data representation of at least one physical feature of said requested content. However, Bengtson teaches the step of receiving print data from printing system/optical scanning/OCR operation (figure 5, block 502). It would have been obvious to one of ordinary skill in the art to recognize that the digital data representation of at least one physical feature of said requested content has been captured from a data capture device (i.e., printing system/optical scanning/OCR operation). Therefore, it were conventionally employed in the art to include a data capture device capturing a digital

data representation of at least one physical feature of said requested content because it would have provided an efficient system to generate and provide a printed publication from the print data provided.

Moreover, in order to support the obviousness of the digital data representation of at least one physical feature of said requested content has been captured from a data capture device. Rabin teaches the digital data representation of at least one physical feature of said requested content has been captured from a data capture device (abstract, figure 1, col. 3, lines 2-63, col. 4, lines 54-65, col. 11, lines 20-30). It would have been obvious to one of ordinary skill in the Data Processing art at the time of the invention was made to combine the teachings of Bengtson and Rabin to include data capture device captures at least one physical feature of a request content because it would have an efficient communications system to collect, capture, store and distribute written and optical information over the network.

16. As to claim 6, Bengtson teaches the invention as claimed, wherein the data capture device includes an OCR wand (figure 1).

17. As to claim 7, Bengtson teaches the invention as claimed, wherein the requested content is unencoded with any document identifier other than physical features of the requested content including the at least one physical feature captured with the data capture device (paragraphs 0005-0008).

18. As to claim 8, Bengtson teaches the invention as claimed, wherein the published content of the content repository is indexed according to physical features of the published content (paragraphs 0005-0008, 0038, 0048-0049).

19. As to claim 9, Bengtson teaches the invention as claimed, further comprising capturing document index data and uploading said document index data to said personal computing device, said document index data comprising data identifying a specific publication, wherein said specific publication comprises said requested content (paragraphs 0026-0027, 0049, 0053-*transmits data related to the target network address which may be a digital version of a printed publication, indexes, page numbers to client device*).

20. As to claim 10, Bengtson teaches the invention as claimed, wherein said document index data is captured with said data capture device (figure 5, paragraphs 0048-0049 –*after receiving print data from data capture device (i.e., printing system, optical scanner, parsing and associating index data with print data*).

21. As to claim 11, Bengtson teaches the invention as claimed, wherein said data capture device is set by a user for said document index data (figure 5, paragraphs 0048-0049).

22. As to claim 12, Bengtson teaches the invention as claimed, wherein said document index data further comprises data identifying a specific issue, said specific issue comprises said requested content (paragraphs 0021, 0026).

23. As to claim 13, Bengtson teaches the invention substantially as claimed, wherein said document index data further comprises data identifying a specific edition, said specific edition comprising said requested content (paragraphs 0021, 0026).

24. As to claim 14, Bengtson teaches the invention as claimed, further comprising capturing a page number of said requested content and uploading said page number to said personal computing device (paragraphs 0026-0027, 0049, 0053-*transmits data related to the target network address which may be a digital version of a printed publication, indexes, page numbers to client device*).

25. As to claim 15, Bengtson teaches the invention as claimed, further comprising capturing document index data and uploading said document index data to said personal computing device, said document index data comprising data identifying a specific publication, wherein said specific publication comprises said requested content (paragraphs 0026-0027, 0049, 0053-*transmits data related to the target network address which may be a digital version of a printed publication, indexes, page numbers to client device*).

26. As to claim 16, Bengtson teaches the invention as claimed, wherein said document index data is captured with said data capture device (figure 5, paragraphs 0048-0049 *–after receiving print data from data capture device (i.e., printing system, optical scanner, parsing and associating index data with print data*).

27. As to claim 17, Bengtson teaches the invention as claimed, wherein said data capture device is set by a user for said document index data (figure 5, paragraphs 0048-0049).

28. As to claim 18, Bengtson teaches the invention substantially as claimed, wherein said document index data further comprises data identifying a specific issue, said specific issue comprising said requested content (paragraph 0021).

29. As to claim 19, Bengtson teaches the invention substantially as claimed, wherein said document index data further comprises data identifying a specific edition, said specific edition comprising said requested content (paragraphs 0021, 0026).

30. As to claim 20, Bengtson teaches the invention substantially as claimed, further comprising capturing a page number of said requested content and uploading said page number to said personal computing device (paragraphs 0026-0027, 0049, 0053-*transmits data related to the target network address which may be a digital version of a printed publication, indexes, page numbers*).

**Conclusion**

31. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

32. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thu Ha Nguyen, whose telephone number is (703) 305-7447. The examiner can normally be reached Monday through Friday from 8:00 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ario Etienne, can be reached at (571) 272-4001.

Any inquiry of a general nature of relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-9600.

The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9306 for regular communications.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Bharat Barot.

BHARAT BAROT
PRIMARY EXAMINER

Thu Ha Nguyen

June 1, 2005